

PATENT
Attorney Docket No: 102258.262

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: **Stamler, et al.**

Serial No.: **09/092622**

Filed: **June 5, 1998**

For: **NITROSATED AND NITROSYLATED HEME PROTEINS**

Assistant Commissioner for Patents
Washington, D.C. 20231

EXHIBIT G

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A PARTNERSHIP INCLUDING PROFESSIONAL CORPORATIONS

CHICAGO
 DALLAS
 LOS ANGELES

875 THIRD AVENUE
 NEW YORK, NEW YORK 10022
 TELEPHONE 212 906 2000
 FACSIMILE 212 906 2021

FOUNDED 1866

WASHINGTON D.C.
 LONDON
 SINGAPORE
 TOKYO

WRITER'S DIRECT NUMBER
 (212) 906-2343

WRITER'S E-MAIL ADDRESS
 mwaldbau@sidley.com

December 16, 1998

*By Facsimile (w/o enclosures)
 Confirmation by Federal Express (w/ enclosures)*

Gretchen A. Rice, Esq.
 Hale and Dorr LLP
 60 State Street
 Boston, Massachusetts 02109

Re: Jonathan Stamler et al., U.S. Application No. 09/092,622 entitled Nitrosated and Nitrosylated Heme Proteins - Your Ref. - 102258.262; and U.S. Application Nos. 08/438,418 and 08/460,465, entitled Localized Use of Nitric Oxide Adducts to Prevent Internal Tissue Damage - Your Refs. 102258.210 and 102258.214

Dear Gretchen:

Further to our November 30, 1998 letter, the following is a detailed response to your letters of November 20, 23, 30 and December 2, 1998.

U.S. Application No. 09/092,622

Dr. Stamler not only has a legal right to refuse to sign the combined Declaration/Power of Attorney corresponding to U.S. Application No. 09/092,622 ('622), he is in fact legally prohibited from signing this document. 37 C.F.R. §1.63¹ prohibits Dr. Stamler from signing this combined Declaration/Power of Attorney because Dr. Stamler maintains that the inventors named in this declaration are not the original and first inventors of the subject matter which is claimed and for which a patent is sought.

The claims of the '622 Application are not enabled by its written description which is identical to that of the parent application, U.S. Application No. 07/943,835, filed September 14, 1992. The teaching in this application and the specification at pages 1-59 or figures 1-30 do not

¹ 37 C.F.R. §1.63(b) (1998) requires that "the oath or declaration must state that the person making the oath or declaration . . . [b]elieves the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought."

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show enablement for the broad claims as stated for a compound comprising a thiol containing heme protein and an NO or NO₂ group which is directly or indirectly linked to said thiol. For example, the description of S-nitrosylation of hemoglobin at pages 19-20 and 58-59 and figures 28 and 29 does not actually enable production of S-NO-Hemoglobin. In fact, the work which enables the claimed subject matter of this application was completed by Dr. Stamler at Duke University several years after the parent application was filed. The Brigham's filing of the '622 application is an attempt to appropriate subject matter invented by Dr. Stamler at Duke University. Accordingly, because Dr. Stamler maintains that the inventors named on this declaration did not invent the subject matter claimed, he has every right and is in fact legally obligated to refuse to sign the combined Declaration/Power of Attorney corresponding to the '622 application.

For the reasons stated above, Dr. Stamler is also prohibited from signing the Assignment corresponding to the '622 Application. Because Dr. Stamler maintains that the inventors named on the subject application did not invent the claimed subject matter, he cannot swear, as the Assignment requires, that the named inventors for the subject application have full right to convey the entire interest of the application. Moreover, as we have stated in past correspondence with The Brigham and Nitromed, The Brigham possesses no rights in subject matter invented by Dr. Stamler *after* Dr. Stamler terminated his relationship with the Brigham. Accordingly, Dr. Stamler has every right and is in fact legally obligated to refuse to sign the Assignment corresponding to the '622 Application.

U.S. Application Nos. 08/438,418 and 08/460,465

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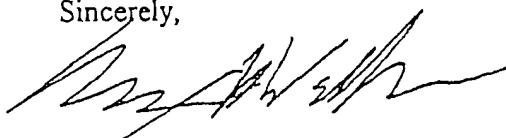
Gretchen A. Rice, Esq.

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Please contact me if you have any questions or wish to discuss this matter further.

Sincerely,



Maxim H. Waldbaum

TAH:jf
Enclosurescc: Dr. Robert L. Taber (w/o enclosures)
Dr. Jonathan Stamler (w/o enclosures)